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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/736,683	
	Filing Date	December 13, 2000	
	First Named Inventor	Elie Koskas	
	Group Art Unit	2171	
	Examiner Name	Etienne Pierre Leroux	
Total Number of Pages in This Submission		Attorney Docket Number	28944/36991

ENCLOSURES (check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual Name	MARSHALL, GERSTEIN & BORUN Thomas A. Miller - 40,091
Signature	
Date	October 22, 2003

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#10
Docket No.: 28944/36991
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Elie Koskas

Application No.: 09/736,683

Group Art Unit: 2171

Filed: December 13, 2000

Examiner: Etienne Pierre Leroux

For: METHODS OF ENCODING AND
COMBINING INTEGER LISTS IN A
COMPUTER SYSTEM, AND COMPUTER
SOFTWARE PRODUCT FOR
IMPLEMENTING SUCH METHODS

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

This paper is in response to the official action dated October 3, 2003 setting forth a restriction requirement in the above-identified application. A provisional election is made herein, with traverse, as set forth below. Reconsideration and withdrawal of the restriction requirement is respectfully solicited.

The above-referenced office action requested that a restriction be made between one of three purported inventions identified by Groups I, IIa, and IIb, wherein Group I corresponds to claims 1-30, Group IIa corresponds to claims 31-43, as well as 64-72, and Group IIb corresponds to claims 44-63. In so far as the restriction is concerned between Groups I and IIb, the applicants respectfully traverse the requirement.

Claims 1-30 (Group I) are drawn to a method of coding integer lists, while claims 44-63 (Group IIb) are drawn to a computer program for so encoding integer lists. In support of the requirement, the Examiner simply states that the claims fall within separate classifications of the U.S. Patent and Trademark Office and thus should be separated out into separate applications. However, this does not meet the criteria for restriction requirement as governed by MPEP §803. Section 803 requires two criteria for a proper requirement of restriction. First, the inventions must be independent or distinct as claimed. Second, regardless of whether the inventions are independent or distinct, there "must be a serious burden on the Examiner if restriction is required."

Regarding the second requirement, section 803 recites that "if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." The term "distinct" is defined in the MPEP as meaning that two or more subjects as disclosed are related, for example, as combination and sub-combination thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sales as claimed, and are patentable over each other. Here, there is no evidence in the record that search and examination of the entire application, or at least Groups I and IIb, would be any burden, much less a serious burden, on the Examiner as is necessary for upholding a proper restriction requirement.

To further support the applicant's position, applicant submits that a complete search of the claims in either Group I or IIb would require a search directed to the subject matter of the claims not elected. Since the search and examination of the entire application can therefore be made without serious burden on the Examiner, it is wasteful of the time, effort and expense of the applicant and the patent office to prosecute the claims in separate applications. Search and examination of the claims of both Group I and IIb in this application will be much more efficient than requiring both the patent office and the applicant to do so separately in multiple applications.

The applicant, therefore, traverses the restriction requirement on the grounds that the minimum standards for a proper requirement set forth in MPEP §803 have not been met. The restriction requirement should be withdrawn and all the claims of Groups I and IIb

should therefore be searched and examined in the present application. Such action is hereby respectfully solicited.

Notwithstanding the above, and to meet the requirements for a complete response, the applicant hereby provisionally elects the claims of Group I corresponding to claims 1-30, drawn to a method of encoding an integer lists, for further prosecution in the pending application, should the examiner maintain his position.

Also notwithstanding the above, while it appears the election of Group I will render the election of species requirement between Groups IIa and IIb moot, should this not be the case applicant hereby elects the claims of Group IIb corresponding to claims 44-63 drawn to a computer program for encoding integer lists.

In light of the foregoing, reconsideration and withdrawal of the restriction requirement is solicited. Should the Examiner have any questions, he is respectfully invited to telephone the undersigned.

Dated: October 22, 2003

Respectfully submitted,

By 

Thomas A. Miller

Reg. No.: 40,091

MARSHALL, GERSTEIN & BORUN, LLP

233 S. Wacker Drive

6300 Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorneys for Applicant